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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/688,513 | 10/17/2003 | Amy E. Battles | 200209018-1 | 1997 |
| 22879 7590 04/04/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400 | | | EXAMINER WOODS, ERIC V | |
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| | | | 2628 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/688,513

Applicant(s)

BATTLES, AMY E.

Examiner

Eric Woods

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/2006 has been entered.

Response to Arguments

Applicant has canceled all claims (1-29) and provided a new set of claims (30-41). Thusly, all rejections and objections to the canceled claims stand withdrawn.

Examiner finds that the newly added claims have support in the originally filed specification in the locations pointed out by applicant in the Remarks filed with the RCE on 12/14/2006.

Applicant's arguments with respect to the patentability of the present claims over the prior art of record have been considered, but are moot since 1) the newly filed claims are considered *de novo* against all available, eligible art, not simply that previously applied, and 2) the cited material in applicant's specification merely provides support and/or antecedent basis for the claims, e.g. has a processor with accompanying memory that executes the recited process / processing step(s).

Claim 30 needs to make clear where the selected area acted upon by the display controller comes from, as this is only implied. Examiner presumes that it comes from line 7 of the claim.

It is noted that the recitations after "a display controller configured to" in claim 30 do not receive patentable weight they are not structure. Any display controller is operable to meet that particular limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 USC 112, second paragraph, for failing to specifically point out and set forth what applicant regards to be his invention.

The fourth clause, "logic for" seems to invoke 35 USC 112 sixth paragraph as set forth in *Massachusetts Institute of Technology v. Abacus Software*, 80 USPQ2d 1225 (Fed. Cir. 2006), given that "logic for" is 'a generic structural term that, standing alone, is synonymous with "means" and connotes no more structure than "means," (cf. 1231-1232), and it is not proceeded by any other terminology. Such element is therefore rejected under 35 USC 112, second paragraph, for failing to expressly point out what elements constitute the recited 'logic for,' which corresponds to 'means'.

Given that applicant has written the claims in such a manner as to appear to invoke 35 USC 112 6th for some elements and not for others, applicant is requested to please clarify, which, if any elements should or not be given such protection, and also

specifically point and set forth what elements within the specification and/or drawings are intended to be the recited 'logic for' performing the recited task.

Claims 31-34 are rejected as not correcting the deficiencies of their parent claim(s).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 30-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ojima et al (US PGPub 2003/0133025 A1) in view of Parulski et al (US PGPub 2005/0146616 A1).

As to claim 30 (system) and claim 35 (method),

Claim 30 (new): A digital camera, comprising: (Ojima Figure 1, Abstract)

-An image display configured to display an acquired image; (Ojima Figure 1, LCD monitor 41)

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-A magnification control, including a zoom-in switch, accessible by a user of the digital camera to thereby allow the user to controllably magnify the acquired image; (Ojima clearly has a magnification control – see Figure 1 – element 33 – operation panel [0019], [0025] – “The operation panel 33 can include ... a zooming button, a cross-shape button, etc...” where clearly this would constitute a ‘zoom in’ and ‘zoom out’ switch, since it specifically causes the zoom ratio to increase or decrease, as in [0027-0029])

-A position control, including an up switch, a down switch, a left switch, and a right switch, and accessible by a user of the digital camera to thereby allow the user to controllably select an area of the acquired image; (Ojima has a cross-shape button on the operation panel 33 [0029], where this button is operable to move the marking area around the base image, and the operator can move up and down, as in [0030], and the user can change the zoom ratio – specifically, see [0034], where it is specified that when the marked area zoom is the same as the display zoom, the entire marked area takes up the entire LCD, such that any operations that pan the marked area will also pan the underlying image as required)

-Logic for providing a bounding box to identify the selected area; (Ojima illustrates bounding box generated by digital camera in Figures 3(a)-(d) (exemplary, [0022-0026, 0039, and the like], where the zoom indicator box or cross is shown on the display of the digital camera. Therefore, the digital camera must contain logic for doing so.)

-A display controller configured to: (Ojima, CPU 30, which controls display of information on display 41, which is operably coupled via system bus)

-Display the acquired image on the image display; (Ojima Figures 3(a) and 4(a), where the base representation is presented to the user first – see box 42 on the right showing the display area ratio, which is at 1X, that is, normal viewing and size [0034-0035, 0036 and 0038 particularly]. Next, the base representation is shown first, as in Figure 2, where steps S102 and S104 can be skipped if the user has not designated a zoom ratio and the like. The important thing is that step S105 must occur, that is, the zoom ratio(s) are displayed on the sub-LCD (area 42, Figures 3(a)-4(d)), and at that time the base zoom ratio of the display is still one))

-Display a portion of the magnified acquired image on the image display; (Ojima- The user then displays the marking box or cross, and then changes the display ratio to actually show the region in question –as in Figures 3(d) and 4(d), so that it occupies the full screen [0034], and the intermediate steps, where the user increases the display ratio to be larger and focus on that specific region. See particularly [0027], where it is specified that the digital zoom function starts as a base image and goes to a magnified image)

-Display the selected area of the acquired image on the image display; and (Ojima clearly shows the zoomed portion as described above, where it is stated that user can move the zoomed portion around [0029] to select aforementioned area. Ojima also shows the bounding box around the selected area (Figures 3(a)-3(d), and similar, as described above. This element lacks antecedent basis, but examiner is interpreting as set forth in 'Response to Arguments.' As described by Ojima [0027-0042] and Figures 2-4(d) inclusive, such elements are shown as part of selecting process. The

bounding box is shown around the selected area as shown in the above-recited Figures (2-4(d) inclusive)))

-Display the bounding box around the selected area on the image display;
((Ojima clearly shows the marked portion on the display, as in Figures 3(a)-3(d) and the like, where the entire purpose of the Ojima is to allow the user to see the position and range of the marking area where the digital zoom operation will be executed – [0030]. Clearly, the system will show the marking area on the base image as soon as the display area zoom is returned to a factor of one, so that the user can perceive the position and range of the marking area. The system of Ojima automatically moves the visible indicia of the box as the user pans it and as the user moves about the image.))

Ojima fails to teach that such recited digital camera possesses image transfer means / control that enable transfer of selected portion of image to external device coupled to camera. [It is noted that the system of Ojima only captures the portion of the image that is within the marked region – see [0047-0048], where once the area is selected it is captured and transferred to the memory 40 [0028].] Parulski teaches this limitation.

-A transfer control, accessible by the user, to enable the user to transfer digital images from the digital camera to an external device communicatively coupled to the digital camera; and (Parulski Figure 1, digital camera 300 coupled to printer 400 via connectors 352 and 452 via printer interface 322 in camera, where printer 400 is clearly 'external device.' Digital camera displays menus 6A-6J where clearly it configures

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printing options – see process flow in Figure 5. User chooses via shown menu to print image and/or edit image prior to printing (e.g. cropping and the like)- see 516 Figure 5, where clearly the transfer control exists in order to allow the user to print)

-Image-transfer logic, responsive to the transfer control, and configured to transfer the portion of the image within the bounding box, as displayed on the image display, to the external device. (Parulski Figure 1, digital camera 300 coupled to printer 400 via connectors 352 and 452, collectively 342, via printer interface 322 in camera, which clearly constitutes such transfer logic. Specifically, Parulski teaches that a cropped image performed on digital camera 300 only transfers and prints said cropped portion as in Edit Menu I / 516 in Figure 5, with choice 1 – Crop (J), illustrated further in 6J, and [0033, 0041, **0046** specifically])

Parulski is **only** cited for the teaching that it is desirable to allow the user to transfer images to external devices, the means to do so, and the teaching that the user should be able to select to transfer such selected portion (e.g. when and what to print). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ojima to have a transfer control (comparable to print button 446 in Figure 4) with required transfer logic (e.g. printer interface 322) to allow the user to print or transfer the selected portion of the base image to an external device (where it is noted that Ojima only stores the aforementioned selected portion in bounding box / selection rectangle / demarcation elements) because: (a) It is advantageous to display the print menu / e.g. external device controls on the LCD display of the digital camera to

make it large and perform editing therein [0007]; (b) It is advantageous to allow the user to generate hardcopy prints for long-term use directly from a digital camera coupled to it [0009-0010] since no intermediate device (e.g. personal computer) is required; (c) using the digital camera to do so would allow the camera to control the printer, thusly only requiring one device and set of user controls to print recited elements; and the like, as provided by evidence in both references.

As to claim 35 specifically, the display controller functionality referenced above performs the recited steps. Again, see Ojima Figures 3(a)-4(d) to illustrate providing the bounding box, and the discussion above concerning relevant citations within the Ojima reference for moving the bounding box via pan operation and other means.

As to claim 41, this again maps to the rejection of claims 30 and 35, wherein this is a more narrow form of claim 35. Specifically, it differs by recited that the acquired image is magnified, but the second step of functionality under the recited display controller in the rejection to claim 30 includes "displaying the magnified acquired image." As noted above, Ojima teaches (Abstract, various other locations cited above, [0029-0034], etc) that the user moves the position of the magnified image arbitrarily and pans around it, and re-displays image portions responsive to panning, wherein the third clause of the display controller functionality above is "display the selected area of the acquired image on the image display" and finally the rejection above discusses the transferring of only the selected portion.

As to claim 31, Ojima has a cross-shape button on the operation panel 33 [0029], where this button is operable to move the marking area around the base image, and the operator can move up and down, as in [0030], and the user can change the zoom ratio – specifically, see [0034], where it is specified that when the marked area zoom is the same as the display zoom, the entire marked area takes up the entire LCD, such that any operations that pan the marked area will also pan the underlying image as required.

As to claim 32, Ojima shows bounding box / demarcation elements that are non-continuous, e.g. dashed. Further it would have been a matter of design choice for the choice of demarcation line (e.g. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). See MPEP 2144.04(I).)

As to claim 33, Ojima clearly shows indicia that are not dashed lines per se, but rather indicators at the corners of the bounding / selection box. See Figures 3(a)-4(d) *et seq.*

As to claim 34, clearly, as noted in the rejection to claim 30 above, the system possesses the magnification control, where the user can controllably change the zoom level by incrementing or decrementing it is as desired, again as illustrated by Figures 3(a)-4(d) *et seq.*

As to claims 36 and 37, applicant has clearly shown that the order in which the area is controllably selected and the magnification step are not important by claiming first one order of steps and then the other. Therefore, there is no criticality. Further, the functionality described in the rejection to claim 30/35 above describing the display controller clearly executes the magnification of the acquired image on the image display

and then displays the selected portion of the acquired image on the display. It has been held that changing the order of steps in a process, unless it produces unexpected results, is not a patentable distinction over the prior art (MPEP 2144.04, In re Burhans, 154 F.2d 690, 69 USPQ 330 (CCPA 1946); Ex parte Rubin, 128 USPQ 440 (Bd. App. 1959)). See Ojima Abstract.

As to claim 38, Ojima clearly teaches storing only the selected area, and as described above, the combination with Parulski would thusly teach only transferring the selected area (think the cropping function / printing of Parulski). Ojima further teaches that the user can control magnification, and that such position control can be used to pan, etc (repeated from above rejection: (Ojima has a cross-shape button on the operation panel 33 [0029], where this button is operable to move the marking area around the base image, and the operator can move up and down, as in [0030], and the user can change the zoom ratio – specifically, see [0034], where it is specified that when the marked area zoom is the same as the display zoom, the entire marked area takes up the entire LCD, such that any operations that pan the marked area will also pan the underlying image as required))). See Ojima Abstract.

As to claim 39, as noted in the rejection to claim 38 above, Ojima teaches panning the underlying image such that the user can place the bounding box on a different section of the acquired image. The user can clearly select whatever portion of the original or magnified region is desired, and this occurs in whatever order is desired (see discussion with respect to claims 36-37 with respect to the order in which that occurs; see the discussion with respect to claim 38, where the user can move the

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bounding box). The combination of Ojima clearly teaches only transferring the selected portion in any case, where such transfer is user-initiated. Therefore, the user would determine which portion to transfer, wherein the user would select the different portion and then perform the transfer. See Ojima Abstract.

As to claim 40, this combination (e.g. the transfer of only the selected portion to a printer) is clearly shown in the rejection to claims 30 and 35, because the recited external device therein is a printer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Woods

3/30/2007

A handwritten signature in black ink, appearing to be 'K. M. Tung', with a long, sweeping horizontal stroke at the end.

KEE M. TUNG
SUPERVISORY PATENT EXAMINER